

R E M A R K S

A non-final Office Action was mailed on August 26, 2003. Claims 8-12 pending. The allowability of method claims 8-12 has been withdrawn.

Claims 8-9 and 11-12 are now rejected under 35 U.S.C. §102(e) as being anticipated by Walker (U.S. Patent 6,072,467), while claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable over Walker '467 in view of Furukawa JP '760.

Applicant respectfully disagrees with the Examiner that the claims as set forth are taught or reasonably suggested by the cited art. The Manual For Patenting Examining Procedure (MPEP) § 2131 clearly sets forth the standard for rejecting a claim under 35 U.S.C. § 102(b). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (MPEP § 2131, quoting Verdegaal Bros. v. Union Oil Co. of California 2 USPQ2d 1051, 1053 (Fed Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ...claim." (MPEP § 2131, quoting Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). "The elements must be arranged as required by the claim, but this is not an *ipsissimum verbis* test, i.e. identity of terminology is not required." (MPEP § 2131, citing In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990)).

In this case, the Walker reference fails to teach the claimed invention as required by the MPEP. For instance, Walker discloses a hand-held device 20, as in Fig. 1. As in Fig. 2, the device 20 is provided with accelerometers to sense the motion of the device 20. Walker states that the outputs of the accelerometers are analyzed to determine the accelerations of the device 20 (column 6, lines 60-63). In order to eliminate false action, the device 20 is provided with a switch 26 depressable by thumb 28, as in Fig. 1, such that only those motions are detected which occur during the depression of the switch (column 6, lines 63-67). Various movements of the device 20 result in various on-screen motions for the character or icon (column 10, lines 43-45). Also, as in Fig. 9, the accelerometer outputs can be used to represent the value of each of the two parameters for selecting the desired emotion (column 11, lines 16-18). For example, a sadness can be represented by movements which are slow and have small amplitudes, surprise can be represented by fast movements of greater amplitude (column 11, lines 24-26).

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The Examiner asserts that Walker discloses a controller which has pressure-sensitive means for sensing a pushing pressure of the player on the controller generating a pressure-sensing output signal having a variable magnitude (item 4 of the Detailed Action of August 26, 2003). However, Walker does not disclose or suggest any pressure-sensitive means, but only discloses the accelerometers and the switch 26, which accelerometers are not a pressure-sensitive means. The accelerometers only detect the changes in the movements of the device 20. The switch 26 is pressed by a player to function as merely an ON-OFF switch. It does not function as a variable pressure-sensing means.

However, to further clarify the recited "means" language and therefore preclude the applicability of the Walker reference, Applicant has amended claims 8-12 as set forth below:

A method of executing a game program by using a computer that has a controller which has pressure-sensitive means for sensing a variable pushing pressure of a player on the controller and that is able to execute a game program that includes scenes of exchanges between the player or an on-screen character controlled by the player and on-screen other characters, the method comprising the steps of:

generating a pressure-sensing output signal from said pressure-sensitive means, said pressure-sensing output signal having a variable magnitude dependent on said variable pushing pressure, and

transmitting an emotion of the player corresponding to the magnitude of said pressure-sensing output signal to at least one of said other on-screen characters.

Support for such claim amendments is clearly found in the specification and drawings as originally filed. As Walker clearly fails to teach or reasonably suggest the transmission of a variable emotion based on the variable application of a pushing pressure on a pressure-sensitive means, it is respectfully requested that the §102(e) rejection be withdrawn.

With respect to the §103(a) rejection over Walker '467 in view of Furukawa JP '760, Applicant respectfully submits that claim 10 is allowable based on dependency for the reasons set forth above with respect to Walker '467 alone. Furthermore, Furukawa does not disclose or suggest any relationship between a plurality of pressure-sensitive means and a plurality of modes of emotion. Accordingly, one skilled in the art would not be taught or motivated to incorporate

the teaching of Furukawa '760 into Walker '467 to arrive at the claimed invention as doing so would result in a controller with duplicative and materially altered functionality that goes beyond the teaching or concept embodied in Walker '467. Walker's emotional variation is clearly dependent on the multiplicity of axial movements generated by the accelerometers (see FIGS. 7-8J). Incorporating a pressure-sensitive means into the structure of Walker would have no further impact on the emotional variation expressed by the Walker controller. Furthermore, Applicant respectfully submits the Examiner's statement regarding providing game players with the "intention of directly reflecting the operation of the character in a game" is clearly reflective of an improper hindsight teaching as the resultant effect of such a statement goes way beyond the teaching of the combination of Walker and Furukawa.

As the CAFC stresses for a § 103 rejection to stand, the Examiner is required to show **with evidence** the motivation, suggestion or teaching of the desirability of making the specific combination at issue. That evidence is required to counter the powerful attraction of a hindsight-based obviousness analysis. See, for example, *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q. 2d 1430, 1433 (Fed. Cir. 2002) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references"). It is respectfully submitted that this involves more than a mere bald assertion that it would be obvious to combine the cited references. With respect, the Examiner has failed to indicate why one of ordinary skill in the art would be motivated to combine the teachings of Walker and Furukawa to arrive at the claimed invention, i.e., to arrive at the specific steps involved in the claimed method. *In re Lee* requires that the record must state with particularity all the evidence and rationale on which the PTO relies for a rejection and sets out that it is necessary to explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.

Under *Lee*, the PTO must state in writing the evidence on which it bases its rejection. With respect to the above, and because Furukawa clearly fails to disclose any connection between pressure-sensitive means and modes of emotion, among other reasons, the present office

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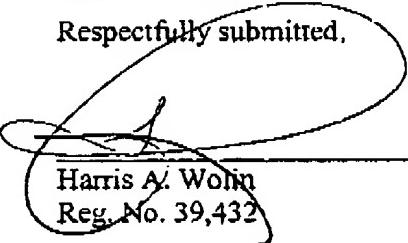
action falls short of this requirement. Accordingly, it is respectfully requested that the Examiner withdraw the rejection under §103(a).

To fully appreciate the scope of the claimed invention, Applicant has added new claims 14 and 15. Claim 14 is directed to the fact that in the present invention, not only the pattern of change in the pressure-sensitive values of a pushing pressure of the player on the controller can be used, but also a stipulated value at a time can be used for a stipulated period of time (see page 7, bottom line, to page 8, first line; page 8, lines 7-8 and lines 14-15 of the specification as filed). The device 20 in Walker does not output any fixed value for a given time. Claim 15 is directed to the fact that variation in emotional output appears to be illustrated and described in connection with FIG. 9 of the Walker reference. However, such variation in Walker only applies to speech attributes and not speech content as disclosed in the present invention (see FIG. 3 of the present specification). Thus, claims 14 and 15 are believed to patentable over Walker '467 in their own right and through dependency on what Applicant considers to be allowable independent claim 8.

In view of the above amendments and remarks, passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, he is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,



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